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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,094	04/17/2001	David A. Hughes	50P4001.01	7732

7590 07/28/2004

MILLER PATENT SERVICES  
2500 DOCKERY LANE  
RALEIGH,, NC 27606

EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/836,094

Applicant(s)

HUGHES ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Referring to claims 1-26. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of copending Application No. 09/836632. Although the conflicting claims are not identical, they are not patentably distinct from each other because in both applications the claims are directed to a method for facilitating a transaction for

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purchasable content over an electronic network, the purchasable content including downloading digital data.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-26 are rejected under 35 U.S.C. 102(a) as being anticipated by digitalriver.com (Ref U).**

Referring to claim 1. Digitalriver discloses a method for facilitating a transaction for purchasable content over an electronic network, the purchasable content including downloadable digital data, the method comprising:

- Maintaining a first presence on the electronic network to which a consumer may connect (Page 3, Clients Web Site);
- Transmitting a page from the first presence to the consumer over the electronic network, the page including information concerning the purchasable content (Page 3, Clients Online Web Store);

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- Receiving a command from the consumer over the electronic network indicating that the consumer wishes the transaction for the purchasable content (Page 3); and
- Automatically linking the consumer to a second presence on the electronic network in response to the command such that the consumer may interact with the second presence over the electronic network to complete the transaction for the purchasable content (Page 3, Secure Purchase).

Referring to claim 2. Digitalriver discloses a method further comprising receiving a commission from an entity associated with the second presence based on the transaction for the purchasable content (Page 10, "...through a fee-based pricing model").

Referring to claim 3. Digitalriver discloses a method wherein an entity associated with the first presence does not have custody of the downloadable digital data (Page 4, "Digital River provides each of the companies in this category with a link off of their web site to their very own software store.").

Referring to claim 4. Digitalriver discloses a method wherein the entity associated with the second presence has custody of the purchasable content (Page 10, "Digital River is the logical choice as an ESD provider because they offer a solid turnkey Web-commerce solution along with the most extensive database of downloadable software products available on the market.").

Referring to claim 5. Digitalriver discloses a method wherein the purchasable content includes at least one of the downloadable digital data and physical storage media (Page 10).

Referring to claim 6. Digitalriver discloses a method wherein the physical storage media includes at least one of optically readable media, magnetically readable media, and mechanically readable media (Page 4).

Referring to claim 7. Digitalriver discloses a method wherein the page is capable of receiving information from the customer sufficient to complete the transaction for the physical storage media (Page 4).

Referring to claim 8. Digitalriver discloses a method wherein linking the consumer to the second presence on the electronic network includes causing transmission of a second page from the second presence to the consumer over the electronic network, the second page including information concerning how to complete the transaction for the purchasable content (Page 3).

Referring to claim 9. Digitalriver discloses a method wherein the second page includes at least one of: (i) registration inputs for registering the consumer; (ii) login inputs for permitting the consumer access to further portions of the second page; (iii) summary information including at least one of a list of the purchasable content selected by the consumer, and remittance information for the purchasable content selected by the consumer; and (iv) billing inputs for receiving information from the consumer concerning a remittance method (Page 17).

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Referring to claim 10. Digitalriver discloses a method wherein the electronic network is the Internet and the first and second presences are respective web sites thereon (Page 18 and Page 19).

Referring to claim 11-20. Claims 11-20 are rejected under the same rationale as set forth above in claims 1-10.

Referring to claim 21-26. Claims 21-26 are rejected under the same rationale as set forth above in claims 1-10.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fritsch, U.S. Patent No. 6,233,682, May 15, 2001, discloses a distribution of musical products by a web site vendor over the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG

July 22, 2004



Jeffrey A. Smith  
Primary Examiner